

REMARKS

Claims 1, 6, and 11-16 are amended. No new matter is added by these amendments. By amending the claims, applicants are not conceding that the claims are unpatentable over the references cited by the Examiner and are not conceding that the claims are non-statutory under 35 U.S.C. 101, 112, and 103, as the claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue these and other claims in one or more continuation and/or divisional applications. Claims 1-20 are pending. No new matter is added by these amendments. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

35 U.S.C. 101 Rejections

Claims 11-15 are rejected under 35 U.S.C. 101 because "the claims are in a non-statutory category." Claims 11-15 are amended to recite a storage medium, which is statutory under 35 U.S.C. 101.

35 U.S.C. 112 Rejections

Claims 1-5 are rejected under 35 U.S.C. 112 because "it is indefinite as to what would happen if a recipient identifier did comprise an email address." Claims 1-5 are amended to recite "retaining the recipient identifier in the e-mail if the recipient identifier comprises an e-mail address," which defines what would happen if a recipient identifier did comprise an email address.

35 U.S.C. 103 Rejections

Claims 1-20 are rejected under 35 U.S.C. 103(a) as unpatentable over Maxwell (U.S. Patent 5,805,810) in view of Brookner (US patent 6,897,973). Applicant respectfully submits that the claims are patentable over Maxwell and Brookner because

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all of the claim elements are not taught or suggested by Maxwell and Brookner and combining Maxwell and Brookner would destroy the purpose of Maxwell, for the reasons argued below.

Claim 1 recites: "removing a recipient identifier from an e-mail ... if a recipient identifier in the e-mail does not comprise an e-mail address; retaining the recipient identifier in the e-mail if the recipient identifier comprises an e-mail address; sending the e-mail, if the e-mail comprises the e-mail address; and sending the e-mail, if any other recipient identifier remains in the e-mail after the removing."

In contrast, Maxwell does not teach or suggest "sending the e-mail, if any other recipient identifier remains in the e-mail after the removing," as recited in claim 1 because the Maxwell messages do not contain valid email addresses. Instead, the Maxwell messages include nicknames or identifiers, which Maxwell determines "corresponding postal address information for based on the identify of the sender" by "referring to the databases." (Maxwell at column 4, lines 30-43.) Thus, Maxwell "permits user to send email messages as postal mail addressed to an intended recipient who may not have access to the Internet by identifying the recipient using an identifier or nickname." (Maxwell at column 4, lines 30-33.)

Maxwell further does not teach or suggest "removing a recipient identifier from an e-mail," as recited in claim 1 because Maxwell never sends its messages because they do not contain valid email addresses, so removing a recipient identifier from an e-mail would serve no purpose in Maxwell and would cause extra processing that decreases performance with no benefit.

Maxwell at column 8, lines 41-44 recites "The message validator 22 extracts from the email ... the identifier of the recipient (addressee) of the email message (step 570)," which merely means that Maxwell reads "the identifier of the recipient" since removing the identifier from the Maxwell message would provide Maxwell with no benefit, as previously argued above.

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Brookner at column 4, line 5 recites "correspondence is sent by email over a TCP/IP link," but modifying Maxwell with Brookner would cause Maxwell to be inoperable because causing Maxwell to send its messages with its identifiers that are not valid email addresses would only result in an error when no valid domain is found to receive the messages. Further, modifying Maxwell to send email over the Brookner TCP/IP link would destroy the purpose of Maxwell, which is to permit users "to send email messages as postal mail addressed to an intended recipient who may not have access to the Internet." (Maxwell at column 4, lines 30-33.)

Brookner also does not teach or suggest "removing a recipient identifier from an e-mail," as recited in claim 1 because Brookner sends its email (Brookner at column 4, line 5), and removing email addresses from the Brookner email would cause the Brookner send email function to be inoperable.

Claims 6, 11, and 16 include similar elements as argued above for claim 1 and are patentable over Maxwell and Brookner for similar reasons. Claims 2-5, 7-10, 12-15, and 17-20, are dependent on claims 1, 6, 11, and 16, respectively, and are patentable over Maxwell and Brookner for the reasons argued above, plus the elements in the claims.

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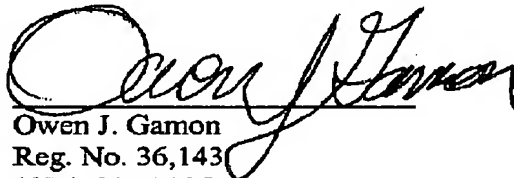
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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,


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CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being transmitted via facsimile to the Commissioner for Patents, 571-273-8300, on November 26, 2007.

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